



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 10
COPY MAILED

GREGORY EINHORN
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER 8th FLOOR
SAN FRANCISCO CALIFORNIA 94111-3834

MAY 25 2000

SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS

In re Application of
Cech et al.
Application No. 08/974,584
Filed: November 19, 1997
Docket No. 015389-00295

:
:
: ON PETITION
:
:

This is a decision on the petition filed November 25, 1998, under 37 CFR 1.183 to waive the "sequence rules" (37 CFR 1.821-1.825) such that applicant does not have to supply a separate identifier number for a subject sequence identified in the petition as well in the specification and claims.

The petition is dismissed. This is not a final agency action.

Petitioner seeks waiver of the rules in that the aforementioned subject sequence is asserted to be equivalent to a composite of several sequences that already have been assigned individual sequence identification numbers under these same regulations. As such, petitioner asserts that "all amino acids found in the subject sequence of this petition except the last "K" may be found in the sequences Listings as filed," and therefore may be independently searched during examination.

Any petition seeking waiver of the rules must establish that (1) the application presents an extraordinary situation, where (2) justice requires waiver of the rules. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985). Petitioner has not shown that either condition exists herein.

Petitioner tacitly concedes that the subject sequence falls within the meaning of the "sequence rules" which mandate the assignment of a specific identification number to the subject sequence. MPEP 2422.03 indicates that it is generally acceptable to present a single, general sequence, assign that a specific identification number, and then to discuss and/or claim variants of that general sequence, with the result that each variant does not also have to be listed as a separate sequence. However, that was not done here. Petitioner appears to have presented each of the fragments of the subject sequence in the listing, and now

seeks to avoid having to also present the subject sequence in the listing.

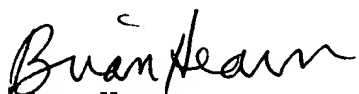
However, MPEP 2423.03 indicates that where a contiguous fragment of a sequence that has already been properly set forth in a sequence listing, that fragment does not need to be separately included. However, having listed the contiguous fragments, petitioner now seeks to avoid presenting the single, general sequence. Had applicant presented the very subject sequence of this petition in the sequence listing, then he would not also have had to presented the numerous composite sequences referred to in the petition. It follows that petitioner seeks to obtain the very converse of the meaning and intent of the sequence rules. Petitioner is reminded that the purpose of the "sequence rules" is to ensure uniformity of sequence input, and thus to generate and maintain a consistently searchable database that is specific to this technology, which is to the benefit of the PTO and the public. While it is unfortunate that petitioner, perhaps unnecessarily, also listed the fragments, the normal practice under the "sequence rules" is to present for listing the single, general sequence, and not the fragments.

Petitioner's inadvertent presentation of the sequence fragments for listing is not an adequate showing of ~~an~~ extraordinary situation~~in which justice requires~~ suspension of the "sequence rules". See, Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing papers). Circumstances resulting from petitioner's failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977).

In balancing the objectives of the sequence rules against any additional work that petitioner's own choice might now entail, inspection of the record does not reveal, and petitioner has not shown, that "justice requires" the relief requested. Petitioner will not be relieved from the necessity to also present the subject sequence for listing herein.

This file is being returned to Technology Center AU 1642.

Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-1820.


Brian Hearn
Special Projects Examiner
Office of Petitions
Office of the Assistant Commissioner for
Patent Examination Policy